



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/853,710	05/14/2001	Tetsuya Kawanabe	862.C2223	6626

5514 7590 11/02/2005

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

LETT, THOMAS J

ART UNIT	PAPER NUMBER
----------	--------------

2626

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/853,710

Applicant(s)

KAWANABE, TETSUYA

Examiner

Thomas J. Lett

Art Unit

2626

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2005.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-21, 74-76 and 92-97 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 16-21, 74-76 and 92-97 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 14 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8.17.04, 11.12.04, 6.24.05, 6.29.05, 7.18.05
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 16, 19, and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
2. Claim 16 recites the limitation "the other device" in line 16, of said claim. There is insufficient antecedent basis for this limitation in the claim.
3. Claim 19 recites the limitation "the other device" in line 17, of said claim. There is insufficient antecedent basis for this limitation in the claim.
4. Claim 21 recites the limitation "the other device" in line 18, of said claim. There is insufficient antecedent basis for this limitation in the claim.
5. Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). As best understood by Examiner, the term "singly" in claims 92-97 is used by the claims to determine a certain printer state, while the accepted meaning is "individually" or "single-handedly". The term is indefinite because the specification does not clearly redefine the term.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 16-21, 74-76, and 92-97 are rejected under 35 U.S.C. 102(b) as being anticipated by Murakami (US Patent 5,550,637).

With respect to claim 16, Murakami discloses an image processing system built by connecting a host device (host computer 2) which reads out and executes program data stored in a storage medium (ROM 13, col. 3, lines 22-28), and a device (printer 1, col. 3, lines 1-5, and see Fig. 1) added with a card device function (Examiner notes that it is inherent that computing devices are commonly constructed of card devices installed within (or within a communicating distance outside of) a housing. These cards interface with a processor via cabling or card slots within the housing or via a connection outside of the housing), wherein said device connected to said system comprises:

communication control unit (CPU 11, col. 3, lines 1-10) adapted to control communication between said host device (host computer 2) and said device (printer 1, col. 3, lines 1-5, and see Fig. 1);

a card interface to connect a card device (Examiner notes that it is inherent that printers are commonly constructed of card devices (e.g., motherboards, modems, RAM, ROM, PCMCIA, floppy disks, etc.) within (or within a communicating distance outside

Art Unit: 2626

of) a housing. These cards interface with a processor via cabling or card slots within the housing or via a connection outside of the housing);

card control unit (CPU 11, col. 3, lines 1-10) adapted to control the card device which is detachably connectable to said card interface (Examiner notes that it is well-known that computers are commonly constructed of card devices (e.g., motherboards, modems, RAM, ROM, PCMCIA, floppy disks, etc.) within (or within a communicating distance outside of) a housing. These cards (both detachable and replaceable) interface with a processor via cabling or card slots within the housing or via a connection outside of the housing);

communication unit (CPU 11, col. 4, lines 13-20) adapted to share device (printer 1, col. 3, lines 1-5, and see Fig. 1) information (control code, col. 4, lines 16-20) between said host device and said card device via said card control means and said communication control means; and

control unit (CPU 11, col. 4, lines 13-20) adapted to allow another device (display 15, col. 3, lines 36-37) connected via said card device to use information shared by said communication means, and when said device is in a power saving mode upon receiving a processing request from the other device connected via said card device, said control means starts a printer initial operation (col. 4, lines 26-36 and power-save decision is determined based on data received, col. 4, lines 49-60), and said control means sends the request information to said host device, and when a request other than the print request is received, said control means does not start the printer initial mode operation (power-save decision is determined based on data received, col. 4, lines 49-60) even

when said device is in the power saving mode, and said communication means sends the request information to said host device.

With respect to claim 17, Murakami discloses a system wherein said card control means has output control means for determining processing performance of said device (printer 1) on the basis of the information shared by said communication means, when said output control means determines that said device can process by itself, a processing request (control code, col. 4, lines 16-20) is output to only said device, and when said output control means determines that said device cannot process by itself, a processing request is issued to said host device and said device.

With respect to claim 18, Murakami discloses a system wherein said device includes a printer device (printer 1, contains printer unit 14, col. 3, line 25).

Claim 19, a method claim, is rejected for the same reason as claim 16.

Claim 20, a method claim, is rejected for the same reason as claim 17.

Claim 21, a medium claim, is rejected for the same reason as claim 16.

With respect to claim 74, Murakami discloses a system wherein said storage medium is a read-only storage medium (ROM 13, col. 3, lines 21-28).

With respect to claim 75, Murakami discloses a method wherein said storage medium is a read-only storage medium (ROM 13, col. 3, lines 21-28).

With respect to claim 76, Murakami discloses a medium wherein said storage medium is a read-only storage medium (ROM 13, col. 3, lines 21-28).

With respect to claim 92, Murakami discloses a printer comprising:

Art Unit: 2626

a first determination unit (CPU 11, col. 3, line 66 – col. 4, line 2, and col. 4, lines 13-20) adapted to determine whether received information is information for a print function;

a second determination unit adapted to, when said first determination unit determines that the received information is the information for the print function determine whether the printer is in a sleep state (CPU 11 detects flag 12C to determine whether the printer unit 14A is in the power save state, col. 4, lines 21-25);

a third determination unit (CPU 11, col. 4, lines 60-67) adapted to, when said second determination unit determines that the printer is not in the sleep state, determine whether the printer can print singly without starting an initial operation, and when said second determination unit determines that the printer is in the sleep state, start the initial operation and determine whether the printer can print singly (power-save decision is determined based on data received, col. 4, lines 49-60); and

a processing unit (CPU 11, col. 4, lines 60-67) adapted to, when said third determination unit determines that the printer can print singly, execute printing in accordance with the received information (control code, col. 4, lines 16-20), when said third determination unit determines that the printer cannot print singly, transmit the received information to a host device (interface 16 transmits data to the host computer 2, col. 3, lines 29-30), and when said first determination unit determines that the received information is not the information for the print function, transmit the received information to the host device (interface 16 transmits data to the host computer 2, col. 3, lines 29-30).

Art Unit: 2626

With respect to claim 93, Murakami discloses a printer comprising:

a first determination unit (CPU 11, col. 3, line 66 – col. 4, line 2, and col. 4, lines 13-20) adapted to determine whether information received from a card device (Examiner notes that it is inherent that computing devices are commonly constructed of card devices installed within (or within a communicating distance outside of) a housing. These cards interface with a processor via cabling or card slots within the housing or via a connection outside of the housing) is information for a print function;

a second determination unit (CPU 11, col. 4, lines 60-67) adapted to, when said first determination unit determines that the information received from the card device is the information for the print function, determining whether the printer is in a sleep state (CPU 11 detects flag 12C to determine whether the printer unit 14A is in the power save state, col. 4, lines 21-25);

a third determination unit (CPU 11, col. 4, lines 60-67) adapted to, when said second determination unit determines that the printer is not in the sleep state, determine whether the printer can print singly without starting an initial operation, and when said second determination unit determines that the printer is in the sleep state, starting the initial operation and determining whether the printer can print singly (power-save decision is determined based on data received, col. 4, lines 49-60); and

a processing unit (CPU 11, col. 4, lines 60-67) adapted to, when said third determination unit determines that the printer can print singly, executing printing in accordance with the information received (control code, col. 4, lines 16-20) from the card device, when said third determination unit determines that the printer cannot print

Art Unit: 2626

singly, transmitting the information received from the card device to a host device, and when said first determination unit determines that the information received from the card device is not the information for the print function, transmitting the information received from the card device to the host device (interface 16 transmits data to the host computer 2, col. 3, lines 29-30).

Claim 94, a control method claim, is rejected for the same reason as claim 92.

Claim 95, a control method claim, is rejected for the same reason as claim 93.

Claim 96, a program storage medium claim, is rejected for the same reason as claim 92.

Claim 97, a program storage medium claim, is rejected for the same reason as claim 93.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Lett whose telephone number is 703-305-8733. The examiner can normally be reached on 7-3:30pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams can be reached on 703-305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2626

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TJL




KIMBERLY WILLIAMS
SUPERVISORY PATENT EXAMINER